

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: <b>French et al.</b>	§	Group Art Unit: <b>2444</b>
	§	
Serial No. <b>09/731,631</b>	§	Examiner: <b>Nguyen, Thanh T.</b>
	§	
Filed: <b>December 7, 2000</b>	§	Confirmation No.: <b>1071</b>
	§	
For: <b>Method and System for Selecting an Operating System at User Login on a Target Device</b>	§	Attorney Docket No.: <b>AUS920000800US1</b>
	§	

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PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on December 12, 2008.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

## **STATUS OF CLAIMS**

### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

The claims in the application are: 1-23

### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

Claims canceled: None

Claims withdrawn from consideration but not canceled: None

Claims pending: 1-23

Claims allowed: None

Claims rejected: 1-23

Claims objected to: None

### **C. CLAIMS ON APPEAL**

The claims on appeal are: 1-23

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to review on appeal are as follows:

### **A. GROUND OF REJECTION 1**

Whether the examiner failed to state a *prima facie* obviousness rejection against claims 1-23 as obvious under 35 U.S.C. § 103 over *Beelitz et al.*, Generation of a Compatible Order for a Computer System, U.S. Patent 6,182,275 (January 30, 2001) in view of *Barr et al.*, Insuring the Integrity of Remote Boot Client Data, U.S. Patent 6,189,100 (February 13, 2001).

## ARGUMENT

The Examiner's answer fails to support the rejection or to counter Appellants' arguments. Each claim has been erroneously rejected as obvious, even though the references fail to teach each claimed element, and also teach away from any such combination.

In short, the Examiner has ignored or misconstrued Appellants' arguments in his Answer. For the convenience of the Board, Appellants will address each 'argument' advanced by the Examiner and illustrate the Examiner's error. Significantly, the Examiner makes no response to the Appellants' "teach away" argument, and thus appears to acknowledge that the references teach away from the combination. The Examiner further failed to address the lack of a likelihood of success from the combination, and apparently agrees with the Appellants that the rejection fails on this ground also.

The Examiner correctly notes that Appellants have challenged the sufficiency of the rejection. However, the Examiner erroneously asserts that the response fails to satisfy 37 C.F.R. §1.111. In fact, Appellants pointed with specificity to how the language of the claims patentably distinguishes them from the reference. Specifically, Appellants previously argued that the references are distinguished from the claims in that the references fail to teach or suggest *inter alia*, "initiating a network bootstrap program at the target device, sending a bootstrap list command from the target device to the server, receiving an operating systems list of at least one operating system prior to executing an operating system at the target device, and selecting a target operating system from the operating systems list, wherein the target device is to be remotely booted by the server." See, for example, Appeal Brief, pages 11- 12.

The Examiner next errs by asserting that Beelitz teaches initiating a network program bootstrap program at the target device. Rather than teach such an element, Beelitz teaches a simple boot, using an operating system loaded onto the target computer. As known to those of skill in the art, simple boots (as taught by Beelitz) are dissimilar to use of network bootstrap. At a minimum, a simple boot is a boot executed by a target computer using only local resources, whereas a network bootstrap allows a computer to boot using resources stored on a networked device and not local. Thus, a simple boot can be executed by a computer that entirely lacks a network connection, whereas a network boot is only operable on a device connected to a network.

The Examiner's next error is in asserting that use of the Barr reference is not indicative of the use of impermissible hindsight. As previously argued by Appellants, one of ordinary skill in the art would not be motivated to seek out the Barr reference based on the Beelitz disclosure as there is no motivation to combine. While the Examiner has correctly cited the MPEP, the Examiner must also apply the law to the facts, and the Examiner cannot sustain the rejections here. Since the references teach away from the combination, as seemingly acknowledged by the Examiner based on his failure to respond, the Examiner can *only* be engaging in a "I-I" reconstruction of the invention, rather than the "teaching suggestion or motivation" that is the state of the law.

The Examiner errs by discounting the fact that the mere possibility of a combination is insufficient to support a rejection. At most, the Examiner argues that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the Barr's (sic) into the computer system of Beelitz to because (sic) it would have to (sic) provided an efficient system that lets a client and server to exchange (sic) a shared encryption key using the secure remote boot process." See, page 11 of the Answer, in which the Examiner failed to correct his typographical errors from ¶5 of the February 27, 2006 office action.

Additionally, the Examiner errs by alleging that Beelitz teaches "the target operating system is selected by a user of the target device". The Examiner's citation to col. 6, lines 35-46 is misplaced. While Beelitz does teach that a user can select an operating system, the user *making* the selection *is not and cannot possibly be* using the target device. Beelitz teaches a build-to-order computer assembly system in which a user can specify the characteristics of a build-to-order computer. However, while the computer is being built-to-order, the customer cannot possibly be using the built-to-order computer. The Examiner is attempting to apply the classic "which comes first, the chicken or the egg" koan to these claims, but the koan is completely inapposite. A customer ordering a computer *cannot use the computer until the computer is built*. Thus, whether or not Beelitz teaches including a tag indicative that the control system is presented to a user is irrelevant to these claims - Beelitz does not teach that the person ordering a built-to-order computer is using the computer being ordered. Therefore, Beelitz cannot possibly support this rejection for at least this additional reason.

The Examiner further errs by alleging that Beelitz teaches a user profile and relocating the network bootstrap program after selection of the target operating system. At most, the Examiner is likening the SDR files of Beelitz to the user profile and updating the central master database to relocation of the network bootstrap program. Neither comparison is appropriate. First, each of these arguments is addressed to dependent claims, so therefore, these arguments cannot support a rejection of the independent claims. Second, with respect to user profiles, the Examiner fails to consider the actual claim language and misstates and misconstrues the Appellants' arguments. Claim 9 requires determining from a user profile, at least one available operating system." Beelitz in view of Barr makes no such teaching. The Examiner has changed his citation to Beelitz, but column 13, lines 32-57 does not teach determining at least one available operating system from a user profile. At most, Beelitz teaches that a SDR file can include customer specific information such as name and address, but does not teach that an available operating system can be determined from a user profile and included in a list of available operating systems.

Likewise, the allegation that Beelitz teaches relocating the network bootstrap program after the target operating system is selected is misplaced. At most, Beelitz teaches use of one or a plurality of control systems for ordering or specifying sessions with a plurality of users. Beelitz makes no teachings of network bootstrap programs or relocating the same after selection of a target operating system. Beelitz only teaches that databases should be updated and that master databases allow for "easy update of the system". See, the Examiner new citation to column 6, lines 55-67.

Thus, the Examiner has failed to prove a prima facie case, and has failed to even address many of Appellants' arguments. Therefore, the rejections in this case should be reversed, and this case passed to prompt issue.

### **CONCLUSION**

As shown above, the Examiner has failed to state valid rejections against the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the Examiner to allow the claims.

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